

Doc Code: PRE.REQ

PTO/SB/33 (07-05)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

110349-133954

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on November 21, 2006Signature Typed or printed name Sally Houk

Application Number

10/644,628

Filed

08/19/2003

First Named Inventor

Robert A. Dunstan

Art Unit

2113

Examiner

Bonzo, Bryce P.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

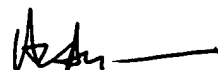
The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record.
Registration number 35432

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____



Signature

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Typed or printed name

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11/21/2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below.

☐ *Total of _____ forms are submitted.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Application for:

Robert A. Dunstan

Application No.: 10/644,628

Filed: 08/19/2003

For: POWER BUTTON AND DEVICE
WAKE EVENT PROCESSING
METHODS IN THE ABSENCE
OF AC POWER

Examiner: Bonzo, Bryce P.

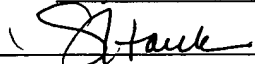
Art Unit: 2113

Confirmation No.: 7514

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Pre-Appeal Brief Review Request

In the Office Action mailed August 22, 2006 ("Final Office Action"), claims of the above-captioned application were rejected. Applicants hereby appeal this decision of the Examiner to the Board of Patent Appeals and Interferences according to 35 U.S.C. §134 and submit a Notice of Appeal in compliance with 37 C.F.R. §41.31 contemporaneously with the present request. Prior to the filing of the Appeal Brief, Applicants respectfully request review the legal and factual basis of the rejections in the above-captioned application in light of the remarks to follow.

Remarks/Arguments

I. Status of Claims

In the subject Final Office Action, claims 1-30 were rejected under 35 USC 112, first paragraph. Rejections against claims 1-30 under 35 USC §103(a) were also maintained. Claims 1-30 were rejected as being unpatentable over Westerinen et al. (US Patent No. 2004/0088589), and in further view of Cooper et al. (US Patent No. 5,838,982).

II. Claims Rejections Under §112 First Paragraph

In the subject Final Office Action, the Examiner accused the Applicant of “blatantly” introducing new matter by replacing the word “ignored” with the word “negated” in the specification. Applicant respectfully submit the Examiner is in gross error.

It is well settled that the “original” disclosure includes the specification, the claims, the abstract and the drawing. Applicant used the words “negate”, “negated” or “negating”, 11 times in 11 of the original 30 claims. None of the original 30 claims used the word “ignore”. Thus, Applicant was clearly in possession of the invention as expressed with the word “negate” (or its variant) at the time of filing.

Applicant has used the word “negate” and its variants at least 3 times in the specification and abstract in support of the claims. For examples, page 15, line 4, page 15, line 12, and the abstract, line 5.

Applicant has also used the word “ignore” in the specification, not considering the word as having a substantial difference in meaning with “negate” at the time of filing. However, in light of the prior art references cited by the Examiner, it appears there ought to be a distinction between the meanings of the two words. Therefore, Applicant undertook to amend the Specification to clarify and conform the description to the claims, which as stated earlier unequivocally recited the invention using the word “negate”, and not once used the word “ignore”.

It is well settled under the prevailing case law, such clarification and conformance amendments are not introducing new matters.

Accordingly, Applicant respectfully submits the Examiner's rejection is improper and requests that the rejections be withdrawn.

III. Claims Rejections Under §103 Rejections

Regarding claims 1, 8, 13, 20, 26 and 29, Westerinen speaks of the ON_BATT signal indicating a culmination of AC power absence and the battery has sufficient energy [e.g. paragraph 0027]; Westerinen, however, fails to speak of a signal indicating of an AC absence condition only. Cooper merely teaches of verifying of system power availability when the power button is pressed, and further continue to check other power source in the absence of system power [e.g. figure 2, column 3, lines 37-38, and column 3, lines 41-43]. Cooper further fails to speak of negating the power button event signal, alternatively the system merely "END"s when all power sources is not available [e.g. figure 2, step 114]. Moreover, applicant reverently disagrees with the examiner in regards to "ignoring" an event signal versus "negating" an event signal. In this context, applicant respectfully suggests that "ignore" implies of refusal of consideration; thus, no corresponding process or element [e.g. figure 2, step 112, the system simply "END"s]. Whereas negation suggests of reversing the polarity of the event signal, implies at least of a process or an element for negation. Therefore, even collectively, Cooper and Westerinen merely instructs of combination of (1) a signal indicating of a sufficient power source (battery) and an AC failure condition, and (2) that the power button is pressed and the system power source is verified.

Applicant fails to see how the above said teaching of Westerinen combined with Cooper, would suggest to one of ordinary skill in the art of the following citation comprising:

- receiving or generating a state signal signalling of the state of an AC failure, presence or absence;

- receiving a power button or wake event signal associated with a power button or a wake event of the apparatus; and
- negating the said event signal if the state signal indicates AC failure or AC absence state.

For at least the above reasons claims 1, 8, 13, 20 26 and 29 are patentable over Westerinen, even if combined with Cooper.

In response to Applicant's argument, the Examiner argued that Westerinen does disclose a signal indicating AC absence, and Cooper does teach AC power loss etc, and thirdly, Applicant may not "remove any reference to ignoring" from the specification.

Assuming *arguendo* the Examiner is correct on the first two points. For reason stated earlier, the Examiner is incorrect on the third point. Applicant is entitled under the law to conform the specification to the original claims, which is part of the original disclosure.

Even if Applicant did not fully conform the specification to the claims, leaving a portion of the original Specification, such as page 15 and the abstract, to use the word "negate", and other portions use the word "ignore", the fair reading of Applicant's specification would be Applicant has described two embodiments, one embodiment employs "negate", and another embodiment employs "ignore". The fact that the original claims all employ the word "negate", simply means Applicant elected to claim only the "negate" embodiment, and not the "ignore" embodiment.

Applicant respectfully submits that the Examiner has no basis to interpret the word "negate" in the claims as equivalent to the word "ignore" which is used in only some portions of the specification, and ignore the fact that the word "negate" is used in other portions and the abstract.

For at least this reason, Applicant respectfully submits the Examiner has failed to fully rebut the patentability reasons set forth in Applicant's last response. Therefore, for at least these reasons previously set forth, claims 1-30 are patentable over the cited references under §103.

Conclusion

In conclusion, claims 1-30 are in condition for allowance. Early issuance of Notice of Allowance is respectfully requested.

The Commissioner is hereby authorized to charge shortages or credit overpayments to Deposit Account No. 500393.

Respectfully submitted,
SCHWABE, WILLIAMSON & WYATT, P.C.

Dated: 11/21/2006



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